



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,441	03/26/2001	Yakov Kamen	isurfTV10	8009

7590 03/24/2004
Kenneth E. Leeds
P.O. Box 2819
Sunnyvale, CA 94087-0819

EXAMINER

NGUYEN, CAO H

ART UNIT	PAPER NUMBER
----------	--------------

2173

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,441

Applicant(s)

Kamen

Examiner

Cao (Kevin) Nguyen

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 26, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 16-46 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 16-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2173

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11, and 16-46 are rejected under the judicially created doctrine of double patenting over claims 1-61 of U. S. Patent No. 6,229,541 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A video system comprising a screen for displaying visual information.

Art Unit: 2173

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See also MPEP § 804.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless:

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-11 and 16-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Gould et al. (US Patent No. 6,556,226).

Regarding claim 1, Gould discloses a video system comprising: a screen for displaying visual information (see col. 16, lines 1-11); and said video system containing one or more

Art Unit: 2173

templates, each template comprising a non-overlapping set of active regions of the screen, whereby when said templates are not activated, said visual information can be seen by a viewer, and when one of said templates is activated, said visual information can still be seen by said viewer (see col. 16, lines 13-61).

Regarding claims 2 and 3, Gould discloses active regions invoke links to a data source (see col. 15, lines 8-40 and figures 8A-8B).

Regarding claim 4, Gould discloses comprising a control device for manipulating the position of the cursor to thereby select one of the active regions (see col. 5, lines 30-67).

Regarding claim 5, Gould discloses a screen for displaying visual information and memory for storing information corresponding to a template, said template establishing a set of regions on the surface of said of screen as active regions (see col. 8, lines 6-53).

Regarding claims 6-8, Gould discloses wherein said video system displays a first image, said first image being annotated such that a set of active areas are associated with said first image, said first image being annotated such that a sel of active areas are associated with said first image, and wherein when said template is activated, active areas associated with said first image are all masked (see col. 8, lines 6-67).

Regarding claims 9-11, Gould discloses wherein said first image is a web page and said active areas associated with said first image comprise hyperlinks (see col. 20, lines 18-67).

Art Unit: 2173

Regarding claims 16 and 17, Gould discloses further comprising a control device for selectively making the active regions of the template visible or invisible, but wherein said active regions remain wherein the template comprises a security feature for denying or permitting access to additional information, wherein said access is obtained by clicking on a predetermined sequence of the active regions of the template (see col. 16-17, lines 1-67).

As claims 18-22 are analyzed as previously discussed with respected to claims 1-11 above.

Regarding claims 23 and 24, Gould discloses displaying a first image on a display device, said display device being part of a display system, and activating a first template over said first image, said first template comprising a set of active areas associated with links, whereby said links can be activated by selecting one offset active areas of invoking comprising moving a cursor to one of said active areas associated with said link (see abstract and col. 10, lines 13-62).

Regarding claims 25 and 26, Gould discloses first image corresponds to a web page comprising hypedinks, wherein when said template is established over said first image, at least some of said hyperlinks are underneath and masked by the active areas of said template (see abstract and col. 9, lines 14-67).

As claims 27-28 and 30-46 are analyzed as previously discussed with respected to claims 1-17 and 23-26 above.

Art Unit: 2173

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gould in view of Rosin et al. (US Patent No. 6,411,307).

Gould fails to explicitly teach further comprising entering a security password into the said password being entered by selecting different active regions of said template.

Rosin teaches entering a security password into the said password being entered by selecting different active regions of said template (see col. 12, lines 21-54). It would have been obvious to one of an ordinary skill in the art at the time the invention was made to provide password being entered by selecting different active regions of said template as taught by Rosin to the content multi-dimensional topic space of Gould in order to provide a secure channel on the viewer for accessing properly.

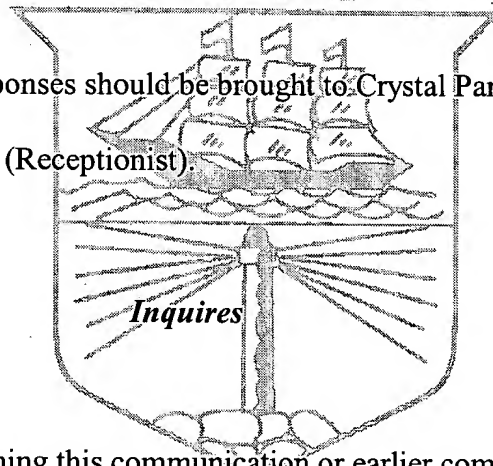
Art Unit: 2173

Response

7. Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 305-9724 for informal or draft communications.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA. Sixth Floor (Receptionist).



8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (703) 305-3972. The examiner can normally be reached on Monday-Friday from 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached on (703) 305-3821. The fax number for this group is (703) 308-6606.

Art Unit: 2173

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

C. Nguyen

March 18, 2004

CAO (KEVIN) NGUYEN
PRIMARY EXAMINER

